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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YASUSHI KATAYAMA : EXAMINER: MUSA, ABDELNABI O.
SERIAL NO: 10/501,082 :
FILED: JULY 9, 2004 : GROUP ART UNIT: 2446
FOR: INFORMATION PROCESSING :
APPARATUS AND METHOD, AND
COMPUTER PROGRAM

APPEAL BRIEF WITH APPENDICES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This appeal brief is submitted in response to the Rejection dated April 27, 2009 and is appropriate because claims in the application are at least twice rejected.

I. Real Party in Interest

The real party in interest in this appeal is the assignee, Sony Corporation.

II. Related Appeals and Interferences

Appellant, Appellant's legal representatives, and the assignees are not aware of any appeals or interferences which will directly affect or be directly affected by this appeal or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 9, 11, 12, 21, 23, 24, and 27 are pending in this case. Claims 9, 11, 12, 21, 23, 24, and 27 have been finally rejected and form the basis for this appeal. Claims 1-8, 10, 13-20, 22, 25, and 26 were canceled. The attached Claim Appendix includes a clean copy of appealed Claims 9, 11, 12, 21, 23, 24, and 27.

IV. Status of Amendments

An Appeal Brief was filed on February 4, 2009 and resulted in an Office Action dated April 27, 2009. Although the Office Action dated April 27, 2009 indicated both a final and a non-final rejection, a telephone Interview Summary dated April 30, 2009 confirmed that the Office Action is non-final. The Office Action indicated that the Appeal Brief filed on February 4, 2009 was not forwarded to the Board of Patent Appeal and Interference and did not place the application in condition for allowance. No amendments have been submitted after issuance of the Office Action dated April 27, 2009.

V. Summary of Claimed Subject Matter¹

The three independent claims, Claims 9, 21, and 27 are summarized below with support for the claim elements indicated in parentheses.

(INDEPENDENT CLAIM 9): An information processing apparatus comprising a data reception unit (Fig. 3, 204; page 30, lines 19-23) a rule decision processing unit (Fig. 3,

¹ It is Appellants' understanding that, under the rules of practice before the Board of Patent Appeals and Interferences, 37 C.F.R. § 41.37(c) requires that a concise explanation of the subject matter recited in each independent claim be provided with reference to the specification by page and line numbers and to the drawings by reference characters. However, Applicants' compliance with such requirements anywhere in this document should in no way be interpreted as limiting the scope of the invention recited in all pending claims. Further, references to the specification and drawings are only exemplary and do not include every instance of support in the specification for claimed subject matter.

201; page 30, lines 19-23) configured to determine whether data processing based on a data processing request received via the data reception unit is to be executed (Fig. 3, 204; page 31, line 22, to page 32, line 3) and a data processing unit configured to execute data processing based on the determination of the rule decision processing unit (Fig. 3, 202; page 30, lines 19-23) wherein the rule decision processing unit is configured to execute determination processing for determining whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor, and the rule deciding condition descriptor is determined based on a probability value (Fig. 3, 204; page 31, line 22, to page 32, line 3).

(INDEPENDENT CLAIM 21): A data processing method for analyzing a data processing request received via a data reception unit, and for determining whether the data processing request is to be executed, comprising a rule decision processing step for determining whether data processing based on the data processing request is to be executed (Fig. 8, S104; page 38, line 20, to page 39, line 9) and a data processing step for executing data processing based on the determination of the rule decision processing step (Fig. 8, S105; page 39, lines 20-27) wherein the rule decision processing step determines whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor, and the rule deciding condition descriptor is determined based on a probability value (Fig. 8, S104; page 38, line 20, to page 39, line 9).

(INDEPENDENT CLAIM 27): A computer-readable storage medium (Fig. 20, 902; page 61, lines 3-5) including a computer program for analyzing a data processing request received via a data reception unit, and for determining whether the data processing request is to be executed, , wherein, the computer program, when executed by a processor (Fig. 20, 901;

page 61, lines 1-3), causes the process to perform a method comprising a rule decision processing step for determining whether the data processing based on the data processing request is to be executed (Fig. 8, S104; page 38, line 20, to page 39, line 9) and a data processing step for executing the data processing based on the determination of the rule decision processing step (Fig. 8, S105; page 39, lines 20-27) wherein the rule decision processing step determines whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor, and the rule deciding condition descriptor is determined based on a probability value (Fig. 8, S104; page 38, line 20, to page 39, line 9).

VI. Grounds of Rejection to be Reviewed on Appeal

The first ground to be considered on appeal is whether Claims 9, 21, and 27 are patentable over Abe, et al. (U.S. Pub. No. 2002/0069408, herein “Abe”) in view of Jeyachandran, et al. (U.S. Patent No. 6,567,176, herein “Jeyachandran”) under 35 U.S.C. § 103(a).

The second ground to be considered on appeal is whether Claims 11, 12, 23, and 24 are patentable over Abe in view of Freed, et al. (U.S. Patent No. 7,073,055, herein “Freed”) under 35 U.S.C. § 103(a), further in view of Jeyachandran.

VII. Argument

First Issue

With respect to Claim 9, the Office Action dated April 27, 2009 asserts Abe as teaching every element of the claim except “specifics on how the processing requests are handled in each unit and how processing information determined by the rule decision unit

from the data processing unit to the data reception unit is executed in servers or computer units,” which it asserts Jeyachandran as teaching.

With regard to the recitation, in Claim 9, of “the rule decision processing unit is configured to execute **determination processing for determining whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor**, and the rule deciding condition descriptor is **determined based on a probability value**,” the Office Action of April 27, 2009 asserts, at page 3, that Abe teaches the rule decision processing unit. However, at pages 3 and 4, the Office Action dated April 27, 2009 appears to assert the job execution determination unit 207 of Jeyachandran as teaching the features of Claim 9.

Although the assertions regarding Abe were addressed in Appellant’s Appeal Brief filed on February 4, 2009, they are repeated in the Office Action dated April 27, 2009 without any response. Thus, Appellant’s arguments regarding Abe are repeated herein, followed by a discussion of Jeyachandran and the combination.

The Office Action dated April 27, 2009, like the Office Action dated September 26, 2008, asserts the access site information retrieval unit 355, depicted at Fig. 4 of Abe, as teaching a data reception unit as defined by Claim 9; the request 350c, made at step S470 at Fig. 8 of Abe, or the information request fee at step S413 at Fig. 2 of Abe, as teaching the processing request as defined by Claim 9; the rule decision unit 22, depicted at Fig. 10 of Abe and making up a part of the CM detection unit 352 of Abe, as teaching a rule decision processing unit as defined by Claim 9; and the processor 44, described at paragraph [0258] of Abe as having the functions of the CM candidate detector 19, supplementary condition calculation unit 20, supplementary condition decision unit 21, rule decision unit 22, and CM probability database 103, as teaching the data processing unit as defined by Claim 9.

However, as Appellant has argued repeatedly, Abe does not teach or suggest at least a rule decision processing unit, as defined by Claim 9.

The request 350c, described at paragraph [0083] of Abe and made at step S470 of Fig. 8, is processed by the access site information retrieval unit 355 with no determination by the rule decision unit 22 based on the request 350c. Specifically, paragraph [0083] describes that, based on the request 350c, the access site information retrieval unit 355 either outputs information indicating that the requested CM access site information has not been registered or outputs the access site information 355a.

The request at step S413 of Abe is described at paragraphs [0069] and [0070] as related to the above discussion of request 350c and is also processed without a determination by the rule decision unit 22. If the access site information retrieval unit 355 outputs access site information 355a to the consumer terminal 303, the consumer terminal 303 is billed, which is why step S413 is labeled as the information request fee step S413 at Fig. 2. Most significantly, paragraph [0070] of Abe describes that the “retrieval of the access site information corresponding to the information request at step **S413** is made automatically by the access site information furnishing device **305**.”

Thus, whether referred to as the request 350c, the request at step S470, or the request at step S413, none of these requests teaches a data processing request as defined by Claim 9. Even if, *arguendo*, an information request can reasonably be interpreted to teach a data processing request, none of the request 350c, the request at step S470, or the request at step S413 teaches a data processing request for which Abe teaches a “unit configured to determine whether data processing based on a data processing request...is to be executed,” as recited by Claim 9. Instead, as discussed above, the request 350c, the request at step S470, and the request at step S413 are all information requests which are always processed without a determination of whether they should be processed.

Abe fails to teach or suggest other features of Claim 9, as well.

The rule decision unit 22 of Abe, which is asserted to teach a rule decision processing unit as defined by Claim 9, does not, in fact, “determine whether processing based on a data processing request received via the data reception unit is to be executed.” In addition to the rule decision unit 22 of Abe not making a determination based on the request 350c, the request at step S470, or the request at step S413, asserted to teach the data processing request as defined by Claim 9, the rule decision unit 22 does not determine whether processing is to be executed at all.

As depicted at Fig. 6 and described at paragraphs [0080]-[0083] of Abe, the tuning/demodulation device 351 separates a received RF signal into a speech signal/video signal/control signal 351a; the CM detection unit 352 then extracts the commercial portion of the aired signal; and the coordinating unit 353 determines if the extracted commercial portion coincides with a registered CM in the CM database unit 354. This CM database unit 354 is also accessed by the access site information retrieval unit 355 to process the request 350c discussed above. The rule decision unit 22 is part of the CM detection unit 352. As described at paragraph [0205] of Abe, “the rule decision unit 22 decides by rule processing which one of the plural concurrent CM candidates is most probable as the CM.”

The Office Actions of September 26, 2008 and April 27, 2009 assert that the decision regarding a given CM by the rule decision unit 22, namely the determination of whether a given CM from a candidate list is to be extracted as the commercial content or not when more than one candidate is identified, as depicted at Fig. 19, teaches a unit “configured to determine whether data processing based on a data processing request received via the data reception unit is to be executed,” as recited by Claim 9. However, because the decision regarding a candidate CM is not based on “a data processing request received via the data reception unit,” as recited by Claim 9, and, further, because the decision is whether to output

the candidate as commercial content or not based on decision processing, rather than “whether data processing based on a data processing request...is to be executed,” as recited by Claim 9, the rule decision unit 22 of Abe does not teach or suggest a rule decision processing unit as defined by Claim 9.

In sum, the decision made by the rule decision unit 22 of Abe is not based on a request, 350c, the request at step S470, or the request at step S413, asserted to teach the data processing request as defined by Claim 9. Further, a decision as to “whether or not the processing according to the processing request is to be executed,” as recited by Claim 9, is not made by the rule decision unit 22 and, therefore, cannot be made “based on a probability value,” as recited by Claim 9.

With regard to Jeyachandran, as shown at Fig. 4 and described at column 15, lines 5-64, a check is performed at step S118 to determine if a registered job can be executed or not. This determination is based on whether performance of the job is possible or must be forwarded to another device. Jeyachandran is silent regarding “**determining whether or not the processing according to the processing request is to be executed...based on a probability value.**”

With regard to the combination of Abe and Jeyachandran, each reference and the combination of the references fail to teach or suggest at least “**determining whether or not the processing according to the processing request is to be executed...based on a probability value,**” as recited by Claim 9.

When a combination of references is asserted as teaching every element of a claim, both the asserted modification, or how the references are combined, as well as the asserted motivation for the combination, or why one of ordinary skill in the art would combine the references, must be specified in the rejection. MPEP § 706.02(V) sets out the requirement for asserting the modification. As to the asserted motivation, the Court recently reiterated the

requirement of MPEP § 2143.01 by stating that a “patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art.” KSR Int. Co. v. Teleflex Inc., 82 USPQ2d 1385, 1389 (2007). The Court stated the importance of identifying “a reason that would have prompted a person of ordinary skill in the art to combine the elements as the new invention does.” *Id.*

Further, under MPEP § 2143.01(V) the proposed modification cannot render the prior art unsatisfactory for its intended purpose, and, under MPEP § 2143.01(VI), the proposed modification cannot change the principle of operation of the prior art.

In this case, the Office Action of April 27, 2009 states, at page 5, that it “would have been obvious...to have modified Abe by the teaching of Jeyachandran to process requests based on their instructions and determine if each unit should process the information or redirect the processing request to other unit in order to efficiently process information requests and reduce the load placed on a user when performing an operation to implement the objective of processing information.”

However, the Office Action of April 27, 2009 makes no proposal for how a CM probability database 103 of Abe might modify Jeyachandran, while meeting the requirements of MPEP § 2143.01, to teach the above-quoted features of Claim 9. Further, the Office Action of April 27, 2009 makes no proposal for how the job execution determination unit 207 of Jeyachandran could modify Abe, while meeting the requirements of MPEP § 2143.01, to teach the above-quoted features of Claim 9. In fact, Appellant cannot discern any specific modification proposed by the outstanding Office Action at all. Thus, the issue of whether an asserted combination teaches all the claim elements is not even reached and a *prima facie* case of obviousness is not established.

For all the reasons discussed above, Appellant respectfully requests that the rejection of Claim 9 under 35 U.S.C. § 103(a) be withdrawn.

Claims 21 and 27, though differing in scope and statutory class from Claim 9, patentably define over the combination of Abe and Jeyachandran for similar reasons as Claim 9. Thus, Appellant respectfully requests that the rejection of Claims 21 and 27 under 35 U.S.C. § 103(a) be withdrawn.

Second Issue

Claims 11 and 12 depend from Claim 9, and Claims 23 and 24 depend from Claim 21. Thus, Claims 11, 12, 23, and 24 patentably define over the combination of Abe and Jeyachandran for at least the same reasons as Claims 9 and 21.

Further, Freed, which is additionally asserted against Claims 11, 12, 23, and 24, does not cure the above-discussed deficiencies of Abe and Jeyachandran with regard to Claims 9 and 11.

Thus, Appellant respectfully requests that the rejection of Claims 11, 12, 23, and 24 under 35 U.S.C. § 103(a) be withdrawn.

Third Issue

Although many of the assertions from the Office Action dated September 26, 2008 are repeated in the Office Action dated April 27, 2009, Appellant's arguments regarding those assertions are not addressed at all. Instead, the Response to Arguments in the Office Action dated April 27, 2009 erroneously asserts that those arguments are moot in view of the current grounds for rejection. Still further, all of the references cited in the Office Action of April 27, 2009 were previously cited and addressed by Appellant. Appellant requests that the arguments presented herein be fully considered and addressed in any subsequent action.

VIII. Conclusion

The rejection dated April 27, 2009 fails to establish a *prima facie* case of obviousness.

Therefore, a reversal of the Examiner's decision is respectfully requested.

Respectfully submitted,

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IX. Claim Appendix

Claim 9: An information processing apparatus comprising:

a data reception unit;

a rule decision processing unit configured to determine whether data processing based on a data processing request received via the data reception unit is to be executed; and

a data processing unit configured to execute data processing based on the determination of the rule decision processing unit, wherein

the rule decision processing unit is configured to execute determination processing for determining whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor, and the rule deciding condition descriptor is determined based on a probability value.

Claim 11: The information processing apparatus according to claim 9, wherein:

said rule deciding condition descriptor is included in a data processing request; and

said rule decision processing unit is configured to generate a random number and to execute determining processing for determining whether or not the processing according to a processing request is to be executed based on a comparison between the generated random number and said rule deciding condition descriptor.

Claim 12: The information processing apparatus according to claim 9, wherein:

said rule deciding condition descriptor is included in a data processing request; and

said rule decision processing unit is configured to perform hash value calculation processing based on the data processing request storing data, and to execute determining processing for determining whether or not the processing according to a processing request is

to be executed based on a comparison between a calculated hash value and a setting value set in its own apparatus in advance.

Claim 21: A data processing method for analyzing a data processing request received via a data reception unit, and for determining whether the data processing request is to be executed, comprising:

 a rule decision processing step for determining whether data processing based on the data processing request is to be executed; and

 a data processing step for executing data processing based on the determination of the rule decision processing step, wherein

 the rule decision processing step determines whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor, and the rule deciding condition descriptor is determined based on a probability value.

Claim 23: The data processing method according to claim 21, wherein:

 said rule deciding condition descriptor is included in the data processing request; and

 said rule decision processing step generates a random number and determines whether or not the processing according to the processing request is to be executed based on a comparison between the generated random number and the said rule deciding condition descriptor.

Claim 24: The data processing method according to claim 21, wherein:

 said rule deciding condition descriptor is included in the data processing request; and

 said rule decision processing step executes hash value calculation processing based on the data processing request storing data, and determines whether or not processing according

to the processing request is to be executed based on a comparison between a calculated hash value and a setting value set in its own apparatus in advance.

Claim 27: A computer-readable storage medium including a computer program for analyzing a data processing request received via a data reception unit, and for determining whether the data processing request is to be executed, , wherein, the computer program, when executed by a processor, causes the process to perform a method comprising:

 a rule decision processing step for determining whether the data processing based on the data processing request is to be executed; and

 a data processing step for executing the data processing based on the determination of the rule decision processing step, wherein

 the rule decision processing step determines whether or not the processing according to the processing request is to be executed based on a rule deciding condition descriptor, and
 the rule deciding condition descriptor is determined based on a probability value.

X. Evidence Appendix

NONE

XI. Related Proceedings Appendix

NONE